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Starkweather & Associates 9035 S 1300 E Suite 200 Sandy, UT 84094		EXAMINER CAJILIG, CHRISTINE T		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/826,990

Applicant(s)

BUCHI, BRYAN M.

Examiner

Christine T. Cajilig

Art Unit

3637

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5/08/07, 5/15/07.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-11 and 21-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-11 and 21-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 and 21, and accordingly, dependent claims 2-6 and 22-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The language of "liner consisting essentially of" is deemed new matter and has not been originally claimed or disclosed. There is absent of indication in the specification that the additional steps or components would materially change the characteristics of Applicant's invention. The transitional phrase "consisting essentially of" is a closed end term. However, since the specification of the invention includes other elements besides what is recited in claims 1 and 21, there is no support for the invention as being claimed in claims 1 and 21. Furthermore, since there are dependent claims that further limit claims 1 and 21, the use of the transitional phrase "consisting essentially of" is improper. Therefore, for examination purposes, the transitional phrase "consisting essentially of" will be interpreted to mean "comprising of."

The following is a quotation of the second paragraph of 35 U.S.C. 112:

Art Unit: 3637

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1, and accordingly, claims dependent therefrom are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, the limitation "wherein after molding, the liner is sized and cut" renders the scope of the claim to be indefinite as it attempts to claim both a liner and a method of making the liner. A single claim which claims both an apparatus and the method steps of making the apparatus is indefinite under 35 U.S.C. 112, second paragraph. See MPEP §2173.05.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 5, and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Scott et al. (U.S. Patent No. 5,268,137).

Regarding claim 1, Scott et al. in Figures 3 and 6 discloses a liner consisting essentially of a flexible first side (62) with a three-dimensional pattern (T, B) protruding therefrom, a flexible second side (30) that is substantially flat and configured to contact a window well; and wherein the liner is a flat and single contiguous sheet that is elastically flexible (as shown in Figure 3) and wherein the liner is capable of being sized and cut in such a configured to attach to a window well. No patentable weight is given to the recitation of a window well. The limitation "after molding, the liner is sized and cut" is a product-by-process limitation and the liner does not depend on the process of making it. The product-by-process limitation "after molding, the liner is sized and cut" would not be expected to impart distinctive structural characteristics to the liner. Therefore, the claimed liner is not a different and unobvious liner from the liner of Scott et al.

Regarding claim 2, Scott et al. discloses the liner as discussed above and further discloses that the first side comprises a pattern of artificial rocks (as better shown in Figure 3) designed to give an appearance of a rock wall.

Regarding claim 3, Scott et al. discloses the liner as discussed above and further discloses that the liner is comprised of polyurethane (Col 6, Ln 13-19).

Regarding claims 5 and 6, Scott et al. discloses the liner as discussed above and further discloses that the liner is capable of being secured with screws to a window well or any other supporting structures and wherein the screws pass through the liner and into a proud section of a window well or any other supporting structure because the liner of Scott et al. is capable of being nailed onto a vertical form (Col 6, Ln 64-68).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5, and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Groves (U. S. Patent No. 5,647,154) in view of Bryant et al. (US 2004/0035063).

Regarding claim 1, Groves in Figure 5 discloses a liner consisting essentially of a flexible first side (36), a flexible second side (the side opposite of 36 where 31 is affixed) that is substantially flat and configured to contact a window well; and wherein the liner is a flat and single contiguous sheet that is elastically flexible (as shown in Figure 5) and is capable of being sized and cut after production so that the liner may be configured to attach to a window well, but does not disclose that the first flexible side has a three-dimensional pattern protruding therefrom. However, Bryant et al. discloses a liner (102) with a three-dimensional pattern (202, 206) protruding from a surface. Therefore, it would have been obvious to a person having ordinary skill in the arts at the time of the Applicant's invention modify the well shield Groves to have a three-dimensional pattern protruding from the first side as taught by Bryant et al. to provide a decorative rock pattern that would suit a consumer's design preference. Furthermore, it has been held

Art Unit: 3637

that "matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art." *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947). Providing a three-dimensional pattern on a surface is an aesthetic design change (i.e., ornamentation only) that would require only ordinary skill in the art, and thus, would have been obvious. No patentable weight is given to the recitation of a window well. The limitation "after molding, the liner is sized and cut" is a product-by-process limitation and the liner does not depend on the process of making it. The product-by-process limitation "after molding, the liner is sized and cut" would not be expected to impart distinctive structural characteristics to the liner.

Therefore, the claimed liner is not a different and unobvious liner from the liner of Groves in view of Bryant.

Regarding claim 2, Groves already modified by Bryant discloses the liner as discussed above and further discloses that the first side comprises a pattern of artificial rocks designed to give an appearance of a rock wall per the modification in claim 1.

Regarding claim 3, Groves already modified by Bryant discloses the liner as discussed above but does not disclose that the liner is comprised of polyurethane (Col 6, Ln 13-19). It would have been obvious to one having ordinary skill in the art at the time of invention to make the window well shield of polyurethane, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Regarding claims 5 and 6, Groves already modified by Bryant discloses the liner as discussed above but does not disclose that the liner is capable of being secured with screws to a window well or any other supporting structures and wherein the screws pass through the liner and into a proud section of a window well. However, Bryant also discloses that a liner is capable of being secured to a supporting structure (104) with screws (210). Therefore, it would have been obvious to a person having ordinary skill in the arts at the time of the Applicant's invention to be able to penetrate the lining of Groves with screws as demonstrated by Bryant et al. to securely fasten a liner.

Claims 7-9, 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Groves (U. S. Patent No. 5,647,154) in view of Bryant et al. (US 2004/0035063) and Poole (U.S. Patent No. 6,484,455 B1).

Regarding claim 7, Groves in Figure 5 discloses a single sheet window well liner (36) secured directly to an inside surface of a window well shield (34) without an intermediate mold, wherein the liner is adaptable to a variety of window shields, but does not disclose that the window well shield is coupled directly to a home and that the first flexible side has a three-dimensional pattern protruding therefrom. However, it is old and well known in the art that window well shields are directly coupled to a home as exemplified by Poole who discloses a window well shield (10) that is directly coupled to a home (52). Therefore, it would have been obvious to a person having ordinary skill in the arts at the time of the Applicant's invention modify the well shield of Bryant et al. to be directly coupled to a home as taught by Poole to rigidly secure the window well

shield. Moreover, Bryant et al. discloses a liner (102) with a three-dimensional pattern (202, 206) protruding from a surface. Therefore, it would have been obvious to a person having ordinary skill in the arts at the time of the Applicant's invention modify the well shield Groves to have a three-dimensional pattern protruding from the first side as taught by Bryant et al. to provide a decorative rock pattern that would suit a consumer's design preference. Furthermore, it has been held that "matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art." *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947). Providing a three-dimensional pattern on a surface is an aesthetic design change (i.e., ornamentation only) that would require only ordinary skill in the art, and thus, would have been obvious.

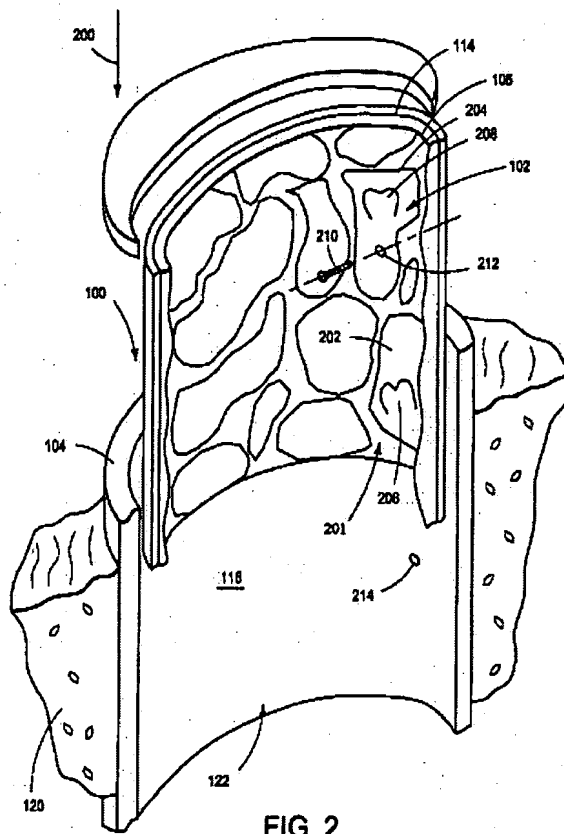
Regarding claim 8, Groves already modified by Bryant and Poole discloses everything previously mentioned, but does not disclose the window well shield is comprised of polyurethane. It would have been obvious to one having ordinary skill in the art at the time of invention to make the window well shield of polyurethane, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Regarding claim 9, Groves already modified by Bryant and Poole further discloses that the first side (106) comprises a pattern of artificial rocks (108), having round and elliptical shapes per the modification of Bryant.

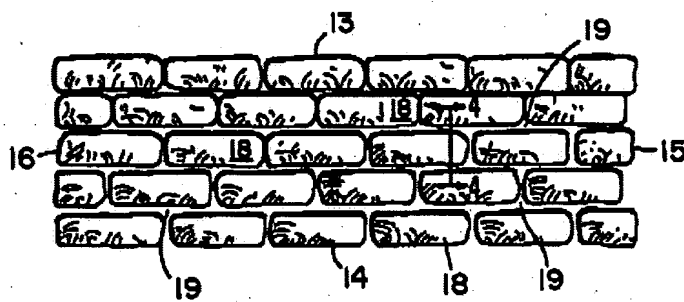
Regarding claim 11, Groves already modified by Bryant and Poole discloses the structure discussed above but does not disclose that the window well liner is secured to the window well via screws, which pass through the liner and into a proud section of the window well. However, the use of screws to fasten two abutting structures is old and well known in the art. Nonetheless, Bryant also discloses that the window well shield (102) is secured to a window well (104), with screws (210) that pass through the liner (106, 114) and into a proud section of the window well (104). Therefore, it would have been obvious to a person having ordinary skill in the arts at the time of the Applicant's invention to modify the window well of Groves already modified by Bryant and Poole to further include screws, which pass through the liner and into a proud section of the window well as taught by Bryant to provide a more stable and secure fastening means.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Groves in view of Bryant and Poole as applied to claim 7 above, and further in view of Rygiel (US 6237294).

Regarding claim 10, Groves already modified by Bryant and Poole discloses everything previously mentioned, but does not disclose that the pattern is a series of generally rectangular shaped rocks. Rygiel, however, discloses a decorative panel (10) with rectangular shaped bricks (18). Therefore, it would have been obvious to one having ordinary skill in the art at the time of invention to modify the window well shield of Groves already modified by Bryant and Poole to include a pattern with rectangular shaped rocks as taught by Rygiel, to have a molded panel with a desired pattern.



Bryant et al. (US 2004/0035063) Figure 2



Rygiel (US 6237294) Figure 3

Art Unit: 3637

Claims 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kemerer et al. (U.S. Patent No. 4,290,248).

Regarding claims 21 and 22, Kemerer et al. in Figure 18 discloses a panel/liner of a single flexible polyurethane sheet (Col 14, Ln 49-57, Col 17, Ln 58-62) having a first side (302) and a second side (the surface on the back side of 302), wherein ornamental protrusions (300) extend from the first side; paint disposed over the first side (Col 7, Ln 9-12); and the second side is substantially free of protrusions (Col 25, Ln 66) and wherein the second side is configured to couple directly to a window well, but does not explicitly disclose that the paint is alkyd paint. However, this would obviously include alkyd paint, as alkyd paint is a common oil-based paint, which would be obvious to use to one skilled in the art.

Claim 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kemerer et al. in view of Glover et al. (U.S. Patent No. 6,612,091).

Regarding claim 23, Kemerer et al. discloses everything previously mentioned, but does not disclose a layer providing ultraviolet protection. However, Glover et al. discloses a panel (30) having a UV coating (Col 8, Ln 50-53). Therefore, it would have been obvious to one having ordinary skill in the art at the time of invention to modify the panel/liner of Kemerer et al. to include a layer that provides protection from the elements including ultraviolet rays, as this would prevent deterioration of the color (Col 8, Ln 50-53).

Regarding claims 24 and 25, Kemerer et al. already modified by Glover et al. discloses everything previously mentioned and further discloses that the liner is adapted to include a plurality of screws disposable therethrough and wherein paint would be disposed over the heads of the plurality of screws.

Regarding claim 26, Kemerer et al. already modified by Glover et al. discloses everything previously mentioned but does not disclose that the single flexible polyurethane sheet is sized to match an associated window well shield. It would have been an obvious matter of design choice to modify the panel/liner of Kemerer et al. already modified by Glover et al. to be sized to match an associated window well shield since such a modification would have involved a mere change in the size of the components and would allow for the panel to be used in any situation. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Response to Arguments

Applicant's arguments filed 5/08/07 have been fully considered but they are not persuasive.

In response to the 35 U.S.C. 112 1st paragraph rejection, Applicant's reference to MPEP 2111.03 along with the citation of PPG Industries Inc. v. Guardian Industries Corp. have been noted. However, MPEP 2111.03 merely defines the transitional phrase "consisting essentially of". The specification as originally filed did not present any indication of what it would regard as constituting a material change in the basic and

Art Unit: 3637

novel characteristic(s) of the invention. Thus, the inclusion of the transitional phrase "consisting essentially of", as presented within the amendment of June 26, 2006, constitutes new matter.

Applicant also submits that "the additional steps disclosed are Scott...would impede the purpose of the Applicant's rejection." However, Applicant's argument is directed to a process or a procedure wherein the claims are directed to an article of manufacture.

Regarding Applicant's argument for the 35 U.S.C. 102(b) rejection as anticipated by Scott, Applicant has not pointed out what elements of Scott would materially affect the Applicant's invention. Moreover, the "elements" of Scott described as impeding the purpose of Applicant's invention were method steps and are not germane to the rejection. As such, the response is not deemed persuasive and the rejection is maintained.

Regarding the combination of Groves in view of Bryant, Applicant argues that Bryant would teach away from Groves because the "molded material [as] described in Bryant...would be near impossible and impractical to roll...into a cylindrical tube" as would the material of Groves. However, the rejection uses Groves in view of Bryant wherein Bryant is to teach the aesthetics of a three dimensional pattern in Groves. Whether Bryant can or cannot be rolled is irrelevant since Bryant is not used for the teaching of material but solely for the three-dimensional protruding pattern. Moreover, there is no indication in Bryant that the egress steps or contouring would act in the manner suggested by Applicant.

Art Unit: 3637

Applicant also states that the Office Action failed to "explicitly state reasons for the [combination of Groves and Bryant]." However, the Examiner has explicitly stated the reason for the combination as stated by Applicant and on page 5 of the Office action dated 2/08/07. Nonetheless, Bryant uses the decorative features of the liner to create a "pleasing look and feel" (see Bryant, paragraph 0006).

Applicant's supplemental arguments filed 5/15/07 have been fully considered but they are not persuasive.

With respect to the argument that the combination of Bryant and Groves is improper, the Examiner reemphasizes that Groves is not used to modify Bryant. Instead, Bryant is used to modify Groves.

Applicant also submits that the Examiner has failed to consider secondary considerations. However, Applicant has not submitted such secondary considerations under 37 C.F.R. 1.132.

Applicant's arguments with respect to claim amended claims 1 and 7 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Yamamoto (U.S. Patent No. 5,213,870) a bendable ornamental panel; Nasvik et al. (U.S. Patent No. 5,632,922) a contoured wall liner; Miller et al. (U.S. Publication No. 2001/0012555 A1) a mold liner.

Art Unit: 3637

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christine T. Cajilig whose telephone number is (571) 272-8143. The examiner can normally be reached on Monday - Friday from 9am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on (571)272-6867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3637

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

CTC 
7/19/07

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